



PATENT

Docket No. 1232-4641

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*HT
PA6-9-04*

Applicant(s) : OHTA
Serial No. : 09/649,128 Art Unit : 2612
Filed : August 28, 2000 Examiner : N. Hernandez
For : FOCUS ADJUSTMENT APPARATUS, CONTROL METHOD THEREFOR, AND MEDIUM FOR SUPPLYING CONTROL PROGRAM THEREFOR

RESPONSE TO ELECTION OF SPECIES REQUIREMENTS

Mail Stop - Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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JUN 07 2004

Technology Center 2600

Sir:

Kindly consider the following election in response to the May 3, 2004 election of species requirements.

ELECTION:

The Examiner, in the May 3, 2004 election of species, requires election of one of the following eight distinct species:

- Species 1 : Figures 1-4;
Species 2 : Figures 5-9;
Species 3 : Figures 10 and 11;
Species 4 : Figure 12;
Species 5 : Figure 13;
Species 6 : Figures 14-17;

Species 7 : Figures 18 and 19; and

Species 8 : Figures 20 and 21.

Applicants respectfully traverse the above election of species requirements as being improper and request withdrawal thereof.

Section 803 of the Manual of Patent Examining Procedure (MPEP) indicates that “there are two criteria for restriction between patentably distinct inventions” as follows (emphasis added) to wit:

“(A) The inventions must be independent...; and,

(B) There must be a serious burden on the examiner if restriction is not required....”

Applicants respectfully submit that Species 1-8 (Figures 1-21) are properly presented in the same application and that no serious burden on the Examiner exists. The Examiner has not provided any evidence or line of reasoning to show that the identified species are independent and that a serious burden exists. As such, the Examiner has not satisfied the two criteria identified in Section 803 of the MPEP. Notwithstanding any actual independence or distinction between the identified species, Section 803 of the MPEP requires examiners to search and examine application containing independent or distinct invention when no serious burden to do so exists. Section 803 of the MPEP also states that:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

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The Examiner has not provided any specific discussion, line of reasoning, and/or evidence to support his conclusion that a serious burden, in fact, exists.

In view of the above discussion, it is respectfully submitted that the election of species requirement is improper and should be withdrawn. Accordingly, action on the merits for Species 1-8 is respectfully requested.

Notwithstanding the above discussion, Applicants hereby elects Species 2, Figures 5-9. Applicant respectfully submits that Claims 1-3, 6, 8, and 10-24 are readable on elected Species 2, Figures 5-9. Applicants, nonetheless, reserve the right to file divisional applications based on the non-elected species and claims directed thereto.

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AUTHORIZATIONS:

The Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1232-4641.

Respectfully submitted,
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